

Application No. 10/024,242

Remarks

Applicants thank the Examiner for his careful consideration of the application.

Claims 1-21 stand rejected.

Claim Rejections - 35 USC § 102

Claims 1-21 are rejected under 35 USC 102(b) as being anticipated by U.S. Patent 5,887,216 to Motoyama (the '216 patent). These rejections are respectfully traversed.

Claims 1-11

In claim 1, Applicant recites an aberrant component detection method that includes storing a reference current indicative of proper functioning of a particular component in a computer memory, sensing current supplied to a group of components including the particular component, comparing the current supplied to the group of components to the reference current, and recording a result of comparing the current to the reference current.

The Examiner should withdraw the rejection to claim 1, as the Examiner has failed to establish that claim 1 is anticipated by the '216 patent. The Examiner has failed to establish that the '216 patent anticipates claim 1 because the Examiner has not shown that the '216 patent discloses all the elements of claim 1. Specifically, the Examiner has not, for example, shown that the '216 patent discloses storing a reference current in memory.

A rejection under 35 U.S.C. § 102 can only be supported if each element is literally present in a single piece of prior art. Even if the prior art device performs all the functions recited in the claim, the prior art cannot anticipate the claim if there is any structural difference. MPEP Anticipation under 35 U.S.C. § 102(e) requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 U.S.P.Q.2D (BNA) 1051, 1053 (Fed. Cir. 1987). This rule was reinforced recently by In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999). In Robertson, the claims were drawn to a disposable diaper having three fastening elements. The reference disclosed two fastening elements that could perform the same function as the three fastening

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elements in the claims. The court construed the claims to require three separate elements and held that the reference did not disclose a separate third fastening element, either expressly or inherently. As in Robertson, the Examiner cannot support an assertion of anticipation unless the prior art shows all the claimed limitations.

The '216 patent discloses a method and system for determining that problems exist in a business office device by analyzing the user settings of the business office device. If the user settings deviate from the default settings by a predetermined amount, there is a probability that the default settings are improper, parameters need to be changed within the business office device, or defective components within the business office device need to be changed. The analysis of the user settings is triggered after a predetermined time period expires, after a predetermined number of jobs are performed, or alternatively after a predetermined combination of jobs and elapsed time occurs.

The Examiner has not shown that the prior art discloses, for example, storing a reference current indicative of proper functioning of a particular component in a computer memory. The Examiner asserts that this limitation is shown in FIG. 3 of the '216 patent. The Examiner further asserts that because the '216 patent discloses a method and system for determining that problems exist in a business office device based upon user-set parameters, it would be inherent "to use different current levels in order to detect problems with the system." However, other than these bald assertions, the Examiner has provided no evidence or reasoning to support his position. The Examiner must provide rationale or evidence tending to show inherency. MPEP 2112. "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." Robertson. The abstract appears to indicate that the '216 patent focuses on comparing user settings to the default settings of the device. The Examiner has offered no rationale for assuming that storing a reference current in memory is inherent in the '216 patent and Applicant can see no reason why it would be.

The Examiner appears to have focused on perceived similarities of function between Applicant's claims and the disclosure of the '216 patent. However, as stated above with respect to

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Robertson, even if the prior art device performs all the functions recited in the claim, the prior art cannot anticipate the claim if there is any structural difference.

In fact, the Examiner has identified little in the way of corresponding structure in the '216 patent. Applicant recites (1) storing a reference current indicative of proper functioning of a particular component in a computer memory, (2) sensing current supplied to a group of components including the particular component, and (3) comparing the current supplied to the group of components to the reference current. The Examiner has pointed to no portion of the '216 patent that discloses storing a reference current. The Examiner has pointed to no portion of the '216 patent that discloses sensing current supplied to a group of components. Finally, the Examiner has not shown where Motoyama compares a reference current to a sensed current.

For each of the above reasons, claims 2-11 should be allowed as claims 2-11 depend from claim 1.

Claims 12-18

In claim 12, Applicant recites an aberrant component detection method. The method includes recording a result of comparing a sensed current to a reference current, the sensed current being supplied to a group of components including the particular component, the reference current being indicative of proper functioning of a particular component and being stored in a computer memory.

As noted with respect to claim 1, the Examiner has failed to establish that the '216 reference discloses recording a result of comparing a sensed current to a reference current. Please refer to the discussion of Robertson in response to the rejection of claim 1. As the Examiner has failed to identify structure corresponding to the limitations of claim 12, the rejection should be withdrawn and claim 12 should be allowed.

For each of the above reasons, claims 13-18 should be allowed as claims 13-18 depend from claim 12.

Claims 19-21

In claim 19, Applicant recites an aberrant component detection method. The method includes storing a reference current indicative of proper functioning of a particular component in a computer memory, sensing current supplied to a group of components including the particular component while

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only the particular component draws current, comparing the current supplied to the group of components to the reference current, and recording a result of comparing the current to the reference current. Recording a result comprises at least one of storing the result in a computer memory, displaying an alert when there is a discrepancy between the reference current and the current supplied to the group of components, and recording the circuit to which current was supplied during sensing.

As noted with respect to claim 1, the Examiner has failed to establish that the '216 reference discloses any one of storing a reference current, sensing current supplied to a group of components, and comparing the reference current and the supplied current.

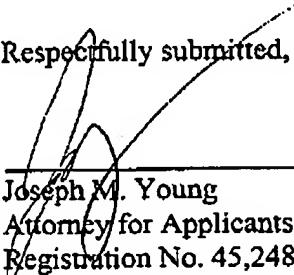
For each of the above reasons, claims 20-21 should be allowed as claims 20-21 depend from claim 19

#### Conclusion

No additional fee is believed to be required for this amendment. However, the undersigned Xerox Corporation attorney hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025. This also constitutes a request for any needed extension of time and authorization to charge all fees therefor to Xerox Corporation Deposit Account No. 24-0025.

A telephone interview is respectfully requested at the number listed below prior to any further Office Action, i.e., if the Examiner has any remaining questions or issues to address after this paper. The undersigned will be happy to discuss any further Examiner-proposed amendments as may be appropriate.

Respectfully submitted,

  
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